

REMARKS

Applicant respectfully requests reconsideration and allowance of the above-captioned application. Claims 1-20 remain pending in the application. Claims 1, 12 and 13 have been amended.

Note that in the response dated January 24, 2006, claim 12 was intended to be amended to correct a minor grammatical error, but was mislabeled as "Original". The label has been changed to "Currently Amended" and the same amendment has been made. It is respectfully requested that the amendment to claim 12 be entered and the entry be acknowledged in any following correspondence. In addition, it is also respectfully requested that the previous amendment to claims 13-15 also be acknowledged.

Claims 1, 2, 5, 6, 8 and 19 have been rejected under 35 U.S.C. §103(a) in view of U.S. Patent No. 4,999,806 to Chernow and first Official Notice (ON1). Claim 3 has been rejected under 35 U.S.C. §103(a) in view of Chernow and ON1, and further in view of a second Official Notice (ON2). Claims 4 and 7 have been rejected under 35 U.S.C. §103(a) in view of Chernow and Official Notice, further in view of U.S. Patent No. 5,918,213 to Bernard. Claims 9, 12 and 20 have been rejected under 35 U.S.C. §103(a) in view of U.S. Patent No. 4,999,806 to Chernow and Official Notice (ON1), further in view of U.S. Patent No. 5,978,775 to Chen. Claims 10, 11 and 13-18 have been rejected under 35 U.S.C. §103(a) in view of Chernow and Official Notice (ON1), and Chen, as applied to claim 9, further in view of U.S. Patent No. 5,918,213 to Bernard.

An exemplary embodiment of Applicant's on-line shopping service encompassed by the independent claims is shown in Figure 2. The on-line shopping service shown in Figure 2 comprises a purchaser 200, a telephone shopping mall server 210 and a seller 230. In an alternative embodiment, a telephone company billing server 220 is also used. The user or purchaser 200 accesses the telephone shopping mall server 210 through a telephone network, and inputs a temporary password and purchase conditions and hangs up. Purchasing conditions can include information such as the name of an article, the class of an article and its price. The telephone shopping mall server 210 retrieves article information meeting the purchase conditions from a database.

The telephone shopping mall server 210 establishes a telephone connection with the purchaser and confirms the identity of the purchaser 200 using the temporary password. The telephone shopping mall server 210 then provides retrieved article information to the purchaser 200. After confirming that the purchaser 200 wants to complete the transaction, the telephone shopping mall server 210 relays arranged transaction information to the actual seller 230, thereby acting as a purchase and sales agent.

In an alternative embodiment comprising the telephone company billing server 220, the charge for the purchase is processed through the telephone company billing server 220 to bill the purchase charge as a telephone charge, thereby providing a convenient payment method for the purchaser 200 and providing a reliable method for collecting a purchase charge to the seller 200.

The system of Chernow is a software distribution system that receives orders over the telephone (Abstract) from a purchaser (Abstract; Fig. 1A, steps a-d). After accepting software order information and credit card information from a caller/purchaser Fig. 1A, steps e and f), the system of Chernow transmits an acceptance key to the caller/purchaser and terminates the telephone call (Fig. 1A, step g, column 6, lines 66-68). The system of Chernow recalls the purchaser and requests the acceptance key (Fig. 1b, "Call Purchaser" step, column 7, lines 5-8). If the acceptance key matches and the credit card transaction has been approved, the software ordered is downloaded to the purchaser.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the cited references must have some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

On pages 2-4 of the Office Action, claims 1, 2, 5, 6, 8 and 19 have been rejected under 35 U.S.C. §103(a) in view of U.S. Patent No. 4,999,806 to Chernow and first Official Notice (ON1).

The Chernow patent does not disclose or suggest the step of receiving a temporary password and purchasing conditions from a caller/purchaser through a telephone connection as recited in claim 1. In contrast, Chernow's system initially

provides the acceptance key to the caller/purchaser. It does not receive a temporary password from the user as recited in independent claim 1 and dependent claim 2.

Chernow does disclose recalling the purchaser and requesting the acceptance key (Fig. 1b, "Call Purchaser" step, column 7, lines 5-8). However, even assuming *arguendo* that this meets the claimed feature of receiving a temporary password, it does not disclose or suggest the claimed feature of receiving the temporary password and purchasing conditions from a user through a telephone connection as recited in claim 1. In fact, Chernow receives the order information from the caller/purchaser prior to providing the acceptance key to the caller/purchaser. Therefore, Chernow does not disclose or suggest the claimed feature of receiving a temporary password and purchasing conditions from a user through a telephone connection as recited in independent claim 1.

Typically, when Official Notice is taken at the onset of prosecution there must be some form of evidence in the record to support the Examiner's assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-45 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; and MPEP §2144.03 (B). Accordingly, the Examiner is respectfully requested to provide some form of evidence to support his assertion that it is common knowledge to use PINs as a temporary password, and why it would be of common knowledge in the art to modify the customer verification system of Chernow.

Additionally, the Office Action provides no motivation for why one of ordinary skill in the art would have been motivated to modify the Chernow patent in a manner to form Applicant's claimed invention. The hypothetical motivation for the

modification appears to be based merely on the skill level of one skilled in the art. It has been held that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The alleged well-known teaching of ON1, even if taken at face value for argument sake, does not overcome the deficiencies of the Chernow patent. Applicant submits that a *prima facie* case of obviousness has not been made because neither Chernow nor the recitation of Official Notice ON1, either individually or in combination, disclose or suggest all of the features claimed in independent claim 1. Therefore, the rejection of claims 1, 2, 5, 6, 8, and 19 should be withdrawn.

Regarding the 35 U.S.C. §103(a) rejections of claims 9, 12 and 20 over Chernow and in view of official notice (ON1) and further in view of U.S. Patent No. 5,978,775 to Chen, the Chen patent does not overcome the deficiencies of the Chernow patent and ON1 noted above. In particular, the Chen patent does not disclose or suggest at least the claimed feature of receiving a temporary password and purchasing conditions from a user through a telephone connection as recited in independent claim 9. Accordingly, the Chernow patent, ON1, and the Chen patent do not disclose or suggest, individually or in combination, all of the features recited in independent claim 9.

The Examiner is requested to provide evidence to support his assertion that it is well known for a telephone customer's telephone account to be charged for charges other than for calls made as a billing convenience, particularly for a system

of online purchases. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-45 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; and MPEP §2144.03 (B).

Therefore, the rejection of claims 9, 12 and 20 is respectfully requested to be withdrawn because the Examiner has not made a *prima facie* case of obviousness due to the fact that the applied art does not teach or suggest all of the claim limitations.

Claims 10, 11 and 13-18 have been rejected under 35 U.S.C. §103(a) in view of Chernow and Official Notice (ON1), and Chen, as applied to claim 9, further in view of U.S. Patent No. 5,918,213 to Bernard.

Regarding independent claim 13, which is directed to a system for providing an on-line shopping service, it recites the feature of wherein the purchasing. Independent claim 13 recites, for example, the features of a database for storing user information, a temporary password provided by the user and article information, and a telephone shopping service processor receiving a temporary password and purchasing conditions from the telephone network connector storing them in a database and retrieving article information meeting the purchasing conditions from the database after the telephone connection to the user ends. These features, among others, recited in the claim are not disclosed or suggested by the applied combination of patents and Official Notice, individually or in combination. For, at least these reasons, the rejection of claims 13-18 should be withdrawn.

Claims 10 and 11 depend from independent claim 9, and the Bernard patent does not overcome the deficiencies noted in the prior art applied in the rejection of claim 9. It is respectfully submitted that the applied prior art, individually or in

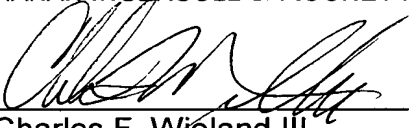
respectfully requested that the rejections of the claims be withdrawn. It is further submitted that the claims are in condition for allowance and notification to that effect is requested.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

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Date: August 1, 2006

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